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Cont'd

102. (Amended) A product for skin, a product for nails, a product for lips, a product for hair, a product for eyebrows or a product for eyelashes comprising:

(a) at least one silicone/acrylate copolymer; and

(b) at least one nonionic polymer comprising at least one vinyl lactam unit chosen from polyvinylpyrrolidone/vinyl acetate/vinyl propionate terpolymers,

wherein said at least one silicone/acrylate copolymer is derived from radical-mediated polymerization of:

(i) at least one ethylenically unsaturated monomer (a); and

(ii) at least one silicone derivative (b) comprising at least one oxyalkylene group.

REMARKS

I. Status of the Claims

Claims 1-33, 38-82, and 87-102 are pending in this application.

Without prejudice or disclaimer, claims 34-37 and 83-86 have been canceled.

Claims 1, 50, 98, and 102 have been amended to point out that the "at least one nonionic polymer comprising at least one vinyl lactam unit" is "chosen from polyvinylpyrrolidone/vinyl acetate/vinyl propionate terpolymers." Support for this amendment can be found, for example, in canceled claims 37 and 86. Moreover, claims 8, 12, 16, 57, 61, and 65 have been amended to remove the term "derivatives." Support for this amendment can be found in the instant specification, for example, at page 4, line 12 – page 7, line 11.

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Accordingly, no new matter has been added by this amendment, nor does this amendment raise any new issues or necessitate the undertaking of any additional search of the art by the Examiner. All of the elements and their claimed relationships were earlier recited in the claims as examined.

II. Double Patenting Rejections

Applicant thanks the Examiner for indicating the double patenting rejection is withdrawn.

III. Rejection under 35 U.S.C. § 112

In the Advisory Action of June 13, 2003, the Examiner maintained the rejection of claims 8-10, 12-16, 19, 20, 26, 57-59, 61-65, 68, 69, and 75, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.¹ Applicant respectfully traverses this rejection for the reasons discussed below.

Claims 12, 16, 57, 61, and 65

With regard to claims 12, 16, 57, 61, and 65, the Examiner asserts that "[t]he term 'derivatives' is vague and indefinite . . . [because] it is neither defined in the specification nor would it be apparent to one of ordinary skill in the art, as this term encompasses an incredible number of chemical possibilities, and thus compounds." Final Office Action, at pages 2-3.

Applicant disagrees with the Examiner. The fact that claim language, including terms of degree, may be broad, does not render the claims indefinite. Rather,

¹ Applicant notes that the Examiner did not state in the Final Office Action dated February 12, 2003, why claim 8 and the claims depending from claim 8 were rejected. Nonetheless, Applicant has amended

acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification. See M.P.E.P.

2173.05(b). Thus, in view of the complete disclosure of the instant specification, Applicant submits that one of ordinary skill in the art would understand what Applicant means by "derivatives," and therefore would be reasonably apprised on the invention. In order to advance prosecution of this application, however, Applicant has amended the claims to remove the term "derivatives." Accordingly, this reason for rejection has been rendered moot.

Claims 19, 26, 68, and 75

With regard to claims 19, 26, 68, and 75, the Examiner asserts that these claims are "vague and indefinite, as they are confusing." Final Office Action, at page 3. Applicant respectfully disagrees. As discussed above, the clarity of a claim depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.

Applicant notes that the Examiner inquires whether "the silicone derivative (b) [is] chosen from compounds of formula I or from derivatives of formula I." Office Action at 3. In reply, Applicant refers to the claim language, which recites that the "silicone derivative (b) is chosen from derivatives of formula I." See, e.g., claim 19. The Examiner also inquires whether "the rest of the claim, which defines formula I, define[s] the derivatives of formula I or does it define the formula, wherein (b) can be chosen from derivatives of the defined formula? *Id.* As expressly recited, the claim defines the

claim 8, consistent with the other basis for the rejection under 35 U.S.C. § 112, i.e., for the use of the term "derivative." Clarification of the record is requested.

derivatives of formula I, wherein (b) can be chosen from derivatives of the recited formula. See, e.g., instant claim 19. Thus, Applicant submits that the subject matter embraced by the claims is clear, as supported by M.P.E.P. § 2173.04.

Accordingly, Applicant request the withdrawal of the rejection.

IV. Rejection under 35 U.S.C. § 103(a)

In the Advisory Action of June 13, 2003, the Examiner maintained the rejection of claims 1-102 under 35 U.S.C. 103(a) as being unpatentable over Blankenburg et al. (WO 99/04750) in view of Myers et al. (WO 94/12148). Applicant respectfully disagrees for reasons of record, and for the additional reason set forth below.

Applicant submits that independent claims 1, 50, 98, and 102, as shown above, have been amended to recite that the "at least one nonionic polymer comprising at least one vinyl lactam unit" is "chosen from polyvinylpyrrolidone/vinyl acetate/vinyl propionate terpolymers. As neither Blankenburg nor Myers teach or suggest these terpolymers, the rejection is improper. Indeed, nothing of record, other than Applicant's disclosure suggests a composition comprising the claimed terpolymers in combination with at least one silicone/acrylate copolymer. For this reason alone, Applicant respectfully requests the withdrawal of the rejection.

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CONCLUSION


In view of the foregoing amendment and remarks, Applicant requests reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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